

Remarks

Further and favorable reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

Referring to the first paragraph on page 2 of the Office Action, wherein the Examiner discusses the restriction requirement, and indicates that no election of species was made by Applicants, please note that Applicants elect the compound of Example 29.

Referring to the first paragraph on page 3 of the Office Action, requiring a cross reference to the PCT application, although such a cross reference is no longer required (MPEP 1893.03(c)), the specification has been amended to insert the cross reference suggested by the Examiner.

The claims have been amended in response to the rejections raised by the Examiner.

Thus, claim 1 has been amended to restrict the definition for the A Group, to a bond (as previously claimed), an alkylene chain having 1 to 12 carbon atoms, or 2,5-dichloro-1,5-pentyl, based on the disclosure in the last two lines on page 3, and page 4, line 9 of the specification.

Claim 1 has also been amended to limit the substituents for R_2 to those set forth in claim 9, as a result of which claim 9 has been cancelled.

Claim 1 has been further amended to limit the substituents for R_3 to those set forth in claim 11, as a result of which claim 11 has been cancelled.

Claims 2, 4, 6, 8, 10 and 12 have been amended to avoid the use of "represented by", in response to item C beginning on page 8 of the Office Action.

Non-elected claims 20-26 have been cancelled. Applicants emphasize that this is without prejudice to their rights under 35 U.S.C. §121 to file a divisional application for the subject matter of these claims.

Claim 29 has been amended to depend on claim 1, thus incorporating the definitions for the variables from claim 1. Amended claim 29 also incorporates the substituents from claim 9.

Claim 35 has been amended to require an inert carrier, in response to item B on page 8 of the Office Action. One skilled in the art would recognize that an inert carrier is used with active ingredients in agrichemicals.

In view of the claim amendments, Applicants respectfully submit that the grounds for rejecting the claims under the second paragraph of 35 U.S.C. §112, beginning on page 8 of the Office Action, have been rendered moot.

The rejection of the claims under the first paragraph of 35 U.S.C. §112, on page 3 of the Office Action, is respectfully traversed.

This rejection is based on the failure of the specification to support the provisos, specifically the last five lines of claim 1. Initially, Applicants note that the first proviso (excluding the case where R₁ represents hydrogen atom, A represents a bond or methylene chain, and R₃ represents phenyl or cyclohexyl) is set forth in original claim 1 of the application, so there is no concern about lack of support for this first proviso. The second and third provisos were inserted to overcome the prior art rejections, as noted in the second paragraph on page 15 of the Amendment filed August 25, 2004. Although Applicants cited In re Johnson, 194 USPQ 187 to show that the second and third provisos do not constitute new matter or render amended claim 1 inadequately supported by the disclosure, the Examiner does not respond to this argument.

Thus, although the Examiner takes the position that the claims contain subject matter “which was not described in the specification” in such a way to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention, Applicants note that in the Johnson decision, the CCPA (now the CAFC) stated that “[the] specification, having described the whole, necessarily described the part remaining” (emphasis added) after excising the invention of another. The invention of another in the Johnson decision was a prior art compound. Similarly, as indicated above, in the present case, the second and third provisos in claim 1 were inserted to overcome the prior art rejections, i.e. to excise the invention of another. The Court in Johnson noted that the specification “described” the claimed subject matter even after a proviso was inserted to exclude a certain prior art compound. Similarly, in the present situation, Applicants respectfully submit that the specification does describe the invention of claim 1 even though provisos have been inserted to exclude certain prior art compounds.

The Examiner also argues that the provisos do not have proper antecedent basis in the specification. However, lack of literal basis in the specification for a negative limitation is not itself sufficient to establish a *prima facie* case for lack of descriptive support. Ex parte Parks, 30 USPQ2d 1234.

In view of these considerations, Applicants respectfully submit that the rejection of the claims under the first paragraph of 35 U.S.C. §112 should be withdrawn.

The patentability of the presently claimed invention after entry of the foregoing amendments, over the disclosures of the references relied upon by the Examiner in rejecting the claims, will be apparent upon consideration of the following remarks.

Thus, the rejection of claims 1-13, 16, 29-32 and 35 under 35 U.S.C. §102(e) as being anticipated by Ricks et al. (US 6,355,660) is respectfully traversed.

This reference is based on a U.S. application filed August 4, 2000 (after Applicants' PCT filing date), but is related to three provisional applications all filed between the filing dates of Applicants' Japanese priority application and PCT application. In order for the reference to be available as prior art against the present invention, it is necessary that the disclosure on which the Examiner relies in the reference be disclosed in one or more of the provisional applications. But even assuming that the provisional applications do have this disclosure, Applicants can still overcome the reference by obtaining the benefit of the filing date of Applicants' Japanese priority application, which was filed November 4, 1998. In this regard, Applicants are submitting herewith a verified English translation of their Japanese priority application. [The Examiner has already acknowledged receipt of a copy of the certified copy of the priority application.] Applicants take the position that in view of this, the Ricks et al. reference is not available as prior art against the present invention, and for this reason alone, the rejection based on this reference should be withdrawn.

The rejection of claims 1, 3, 5, 7, 10, 13 and 35 under 35 U.S.C. §102(b) as being anticipated by Carceller (EP 0 528 172), as well as the rejection of these claims under 35 U.S.C. §103(a) based on this reference, are respectfully traversed.

Applicants take the position that these rejections have been overcome in view of the amendment to claim 1 limiting A to a bond, an alkylene chain having 1 to 12 carbon atoms, or 2,5-dichloro-1,5-pentyl. Such compounds are neither disclosed nor suggested by Carceller.

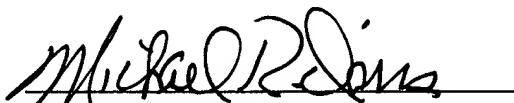
The rejection of claims 1-13, 16 and 29-35 under 35 U.S.C. §103(a) as being unpatentable over Ricks et al. in view Deacon (Modern Mycology) is respectfully traversed.

As indicated above, the Ricks et al. reference is not available as prior art against the present invention. For this reason alone, the rejection based on a combination of Ricks et al. in view of Deacon should be withdrawn.

Therefore, in view of the foregoing amendments and remarks, it is submitted that each of the grounds of objection and rejection set forth by the Examiner has been overcome, and that the application is in condition for allowance. Such allowance is solicited.

Respectfully submitted,

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June 16, 2005